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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,617	12/04/2003	Manuel Buck	033972-002	5757

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EXAMINER

ORTIZ, ANGELA Y

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,617

Applicant(s)

BUCK ET AL.

Examiner

Angela Ortiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-17 in the reply filed on December 20, 2005 is acknowledged. The traversal is on the ground(s) that the Office action has not properly set forth that the product can be made by another method, other than what is claimed in claim 1. This is not found persuasive because the Office action sets forth that the adhesive can be applied independent of the frame; method claim 1 recites that the adhesive be applied through an opening in the frame, thus any method that applies the resin without the use of the frame can be used to make the product of claim 18. While applicant argues that the frame is absent, this was not the position taken in the Office action – only that the adhesive may be applied by another method (one without use of the frame). Note that the method limitations of claim 18 do not further limit the product; claiming the product in terms of the process is permissible, but the patentability of such a claim will be determined by the limitations of the product, see *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985), and MPEP 2113.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 18-21 drawn to an invention nonelected with traverse in Paper dated December 20, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Construction

Note that the preamble language has been construed as intended use and thus not further limiting the claim, and has not been given patentable weight in making the rejections below.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1- 6, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kramer, USP 5,196,153 for the reasons cited in the previous Office action.

The cited reference teaches the claimed method of adhesion of a glass pane with a frame structure comprising the steps of providing a pane of glass 3 on a supporting member 7, and pressing a frame-like structure 1 into contact with the pane of glass 3 such that a sealing lip or peripheral skirt 8 presses the face of the pane of glass 3. An adhesive 2 is injected through the frame-like structure against the pane of glass 3. The adhesive is hardened as desired. With respect to claims 2-4 and 8, note that the undercut annular grooves are concave, and also individual sealing lips and note the configuration of frame 7 as depicted in figures 1 and 2. Note that the passage 12 is provided with two outlets. With respect to claim 6, note that vents passages 14 are provided. Note that the undercut grooves are completely filled with adhesive 2. See col. 3, lines 15-20, 3-57; col. 4, lines 10-25; figures 1 and 2.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 9, 11-17, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer, USP 5,196,153 for the reasons cited in the previous Office action.

The cited primary reference substantially teaches the basic claimed method of adhesion of a glass pane with a frame structure comprising the steps of providing a pane of glass 3 on a supporting member 7, and pressing a frame-like structure 1 into contact with the pane of glass 3 such that a sealing lip or peripheral skirt 8 presses the face of the pane of glass 3. An adhesive 2 is injected through the frame-like structure against the pane of glass 3. The adhesive is hardened as desired. With respect to claims 2-4 and 8, note that the undercut annular grooves are concave, and also individual sealing lips and note the configuration of frame 7 as depicted in figures 1 and 2. With respect to claim 6, note that vents passages 14 are provided. Note that the undercut grooves are completely filled with adhesive 2. See col. 3, lines 15-20, 3-57; col. 4, lines 10-25; figures 1 and 2.

The cited primary reference does not set forth a frame of elastic material, pressing the glass, or the specific materials as claimed.

With respect to claims 7 and 12-15, note that the specific materials as claimed are equivalent to those disclosed in the applied prior art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to so include any

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conventional material when performing the process, depending on the choice of the practitioner, the desired product properties and the material availability.

With respect to claim 9, note that the glass is supported by 7, and is pressed upon when the frame is held in contact therewith using chuck means 4. it would have been obvious to one of ordinary skill in the art at the time the invention was made to so press the glass by applying pressure for firmly holding the glass in place.

With respect to the claimed configuration of the one opening as set forth in claims 16 and 17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to so configure the opening within any number of conventional shapes, depending on the intended use of the opening.

Response to Arguments

Applicant's arguments filed December 20, 2005 have been fully considered but they are not persuasive.

Applicant argues that the applied Kramer reference has nothing to do with windowpanes, and thus the Examiner's reliance thereon is misplaced.

Note that in making the rejection, the Examiner clearly set forth the claim construction (interpretation), stating that the preamble of the claims was not given weight as it merely stated the intended use. The rejection therefore does not need to show the intended use as set forth in the preamble, as it fully meets the positive, manipulative claimed method limitations. Note that the intended use of the claimed invention must result in a structural difference between the claimed invention and the

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prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Note that this position is consistent with MPEP 2111.02 (II). Note that the arguments regarding this feature (specification paragraphs 26-27) further point to intended use.

While applicant may argue that Kramer's frame is not a windowpane frame, it is a frame structure, and the adhesive used is injected through the frame, and both are attached to a glass pane as noted in the rejection. Note that each and every dependent claim limitation is addressed in the art rejection.

Applicant argues the 103 rejection stating that the reference does not teach elastic lips as claimed, and that including such would lead away from that intended in the patented process.

The term "elastic lips" do not include metes and bounds which define what is intended in such a way, that it precludes what is described in Kramer. Note that claims are given their broadest reasonable interpretation in light of the supporting disclosure. In *re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms

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reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

Applicant argues that motivation for the equivalence of the materials claimed has not been shown.

Note that the cited reference incorporates by reference the prior art cited in the application, and states that equivalent plastic materials may be used without departing from the scope of the invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206.

The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaiani can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Angela Ortiz
Primary Examiner
Art Unit 1732

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